

REMARKS

Claims 1-16 remain pending in this application for which applicant seeks reconsideration.

Amendment

Claims 1-16 have been amended to more clearly define the delivery and request aspects of the present invention. Specifically, these claims now more clearly define receiving a digital content from one of the users via a first user terminal together with status information indicating that the received digital content is subject to the legal protection and identifying a content proprietor of the received digital content, requesting for delivery of the registered digital content from a second user terminal, and delivering the registered digital content to another of the user via the second user terminal when the request from the another user over the computer network is received. No new matter has been introduced.

Art Rejection

Claims 1-16 were rejected under 35 U.S.C. § 103(a) as unpatentable over Yamanaka (USPGP 2001/0016834). Applicant submits that Yamanaka would not have disclosed or taught the user delivering and receiving aspects now set forth in independent claims 1, 5, 9, and 13.

Independent claims 1, 5, 9, and 13 each call for delivering the advertising messages over the computer network to the users via the plurality of user terminals, and receiving a digital content from one of the users via the first user terminal together with status information indicating that the received digital content is subject to the legal protection and identifying a content proprietor of the received digital content, which is created as a secondary work by the one user, who is different from the identified content proprietor. The received digital content is registered into the second database together with the status information. These claims further call for receiving a request for delivery of the registered digital content from the second user terminal and delivering the registered digital content to another of the users via the second user terminal when the request from the another user over the computer network is received. At least a part of the advertisement fees collected from the subscribing advertisers is allocated to the content proprietor of the registered digital content identified in the status information.

Applicant previously explained that Yamanaka would not have disclosed or taught submitting works of others by the users of the service who are not the creators or owners. In other words, applicant explained that Yamanaka simply would not have taught a system where

users can legally contribute digital contents owned by others. The examiner contends that paragraphs 137 and 139 disclose submitting a creator's work by another, namely by an agent of the creator or a person who obtains a permission from the creator, thereby disclosing a system where the user can legally contribute content owned by others. According to the examiner the proprietor's agent is deemed to be a third party. Applicant submits that the examiner's argument concerning the holder or agent is misplaced because Yamanaka does not disclose that the holder or agent can submit or receive a secondary work of the original work from **other users** via **user terminals**.

Indeed, in Yamanaka, the agent or a person authorized by the creator to distribute the creator's digital content is treated as a holder 3a, 3b rather than a user 1a, 1b. Moreover, paragraph 139 of Yamanaka discloses that the holder 3a, 3b merely has the permission to distribute the creator's work so that the users 3a, 3b can assess them. There is no mention in paragraphs 137 and 139 (or anywhere else) that the **users 1a, 1b** can add information to the creator's work by another and distribute as a secondary work.

The examiner recognizes that Yamanaka does not disclose or teach the secondary work aspect of the claimed invention. In this respect, the examiner has taken Official Notice that providing a legal notice or creator's information to the work are well known. The issue germane to the patentability is not whether including the legal notice and such would have been known, but rather whether it would have been obvious for the user who has no affiliation with the creator to include such information and contribute. While it may have been known by the creator to include a legal notices or creator's information to his or her own or licensed work, there would not have been any suggestion in Yamanaka for the user 1a to include such a notice or information to the work of another. Accordingly, applicant submits that Yamanaka would not have disclosed or taught the claimed invention.

Note that the presently amended claims call for a user to receive a secondary work, which is a work created by another, with additional information added, from one of the users via a first user terminal (i.e., one of the plurality of user terminals). Moreover, the claims call for receiving a request for delivery of the registered digital content from a second user terminal (i.e., another of the plurality of user terminals). The registered digital content is delivered to another of the users via the second user terminal when the request from the another user over the computer network is received.

In this respect, even if the agent/holder 3a, 3b is deemed to be a third party for argument's sake, since the agent/holder is not a user, such an agent/holder 3a, 3b cannot

request or receive a secondary work of another via a user terminal 11a, 11b. That is, even if the agent/holder 3a, 3b could distribute their own secondary work to the users 1a, 1b for argument's sake, Yamanaka would not have disclosed or taught the agent/holder 3a, 3b requesting or receiving the secondary work from the users 1a, 1b or other agent/holders 3a, 3b via the user terminals 11a, 11b. Accordingly, even under the examiner's own interpretation, Yamanaka still would not have taught the claimed invention within the meaning of § 103.

Conclusion

Applicant submits that claims 1-16 patentably distinguish over the applied reference and are in condition for allowance. Should the examiner have any issues concerning this reply or any other outstanding issues remaining in this application, applicant urges the examiner to contact the undersigned to expedite prosecution.

Respectfully submitted,

ROSSI, KIMMS & McDOWELL LLP

27 APRIL 2007

DATE

/Lyle Kimms/

LYLE KIMMS

REG. No. 34,079 (RULE 34, WHERE APPLICABLE)

P.O. Box 826
ASHBURN, VA 20146-0826
703-726-6020 (PHONE)
703-726-6024 (FAX)